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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,119	01/03/2002	Carter F. Lloyd	2671/4	8414

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EXAMINER

SMITH, JAMES G

ART UNIT	PAPER NUMBER
3723	

DATE MAILED: 04/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/034,119	LLOYD, CARTER F.
	Examiner James G. Smith	Art Unit 3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 February 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 25-48 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 25-48 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on 24 February 2003 is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Drawings***

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 24 February 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 35-41 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are supposedly drawn to a "system" for removing a shingle comprising a shingle and pliers, however it is unclear how the shingle comprises part of the "system" to remove itself.

4. Normally a claim which fails to comply with the first and/or second paragraph of § 112 will not be analyzed as to whether it is patentable over the prior art since to do so would of necessity require speculation with regard to the metes and bounds of the claimed subject matter, **In re Steele**, 308 F.2d 859, 862-63, 134 USPQ 292, (CCPA 1962) and **In re Wilson**, 424 F.2d 1382, 1385, 496 USPQ 494, 496 (CCPA 1970).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 25-27, 29, 31, 42-44, 46 and 48 are finally rejected under 35 U.S.C. 102(b) as being clearly anticipated by Small.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 32-34 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Small.

Small shows an impact device attached to a locking pliers for the express purpose of applying a pulling force to remove an element. It would be obvious to one skilled in the art at the time the invention was made to modify Small by using the device to remove shingles because Small suggests the use of such a pulling tool that is capable of performing the claimed method steps.

9. Claims 28, 30, 45 and 47 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Small in view of either Sandstrom or Wang.

Small shows the claimed invention except for the use of a pivotally attached plate to one or both of the jaws. Either Sandstrom or Wang suggests that a pliers type of tool can have such a pivotally attached plate. It would therefore be obvious to one skilled in the art at the time the invention was made to modify Small by using a pivotally attached plate because either Sandstrom or Wang suggests the use of such a plate attachment method.

***Response to Arguments***

10. Applicant's arguments with respect to claims 25-48 have been considered but are moot in view of the new ground(s) of rejection.

All previous claims have been canceled and new claims 25-48 are now of record.

Claims 35-41 are drawn to some type of "system" for removing a shingle that includes the shingle as part of the "system". This renders these claims indefinite as it is unclear how a combination of a locking pliers tool and a shingle, together, can be used to remove another shingle. The original specification and claims make no mention of this "system" thus it is unclear what applicant is trying to claim.

Applicant argues that neither Jenkin nor Small show the use of a plate attached to a jaw member and that the use of these devices is different than that of applicant. Further, the impact means is attached to a different jaw member than that claimed. As the newly presented claims now recite the specific attachment area for the impact means, i.e. the lower jaw, the patent to Jenkin is no longer applicable. Small, however clearly contemplated attaching the impact means to either jaw member and clearly claimed such in claim 23. Thus this limitation is clearly shown to be

old by Small. With respect to the size of the jaw plates or the use of plate at all, clearly Small shows the use of plates (60) that are attached to each jaw member (15, 17) thus again the claimed limitation is shown to be old. With respect to the method of use now being claimed in claims 32-34, clearly any type of locking pliers with gripping jaws and an attached impact means can be used to pull shingles from a roof area. Small clearly shows a locking pliers tool with an impact means attached thereto for the express purpose of applying a pulling force to remove an element.

Thus the method of use claimed in claims 32-34 is obvious and unpatentable.

### ***Conclusion***

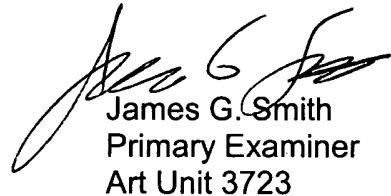
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James G. Smith whose telephone number is 703-308-1746. The examiner can normally be reached on M-Th (7:05- 4:35) first Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on 703-308-2687. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-9835 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



James G. Smith  
Primary Examiner  
Art Unit 3723

jgs  
April 8, 2003